



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/586,240 | 07/17/2006 | Noriko Sugimoto | 2006_0986A | 1802 |

52349 7590 10/14/2010
WENDEROTH, LIND & PONACK L.L.P.
1030 15th Street, N.W.
Suite 400 East
Washington, DC 20005-1503

| |
|----------|
| EXAMINER |
|----------|

COPPOLA, JACOB C

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3621

| | |
|-------------------|---------------|
| NOTIFICATION DATE | DELIVERY MODE |
|-------------------|---------------|

10/14/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ddalecki@wenderoth.com
coa@wenderoth.com

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/586,240 | Applicant(s) SUGIMOTO ET AL. | |
| | Examiner JACOB C. COPPOLA | Art Unit 3621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 8-12 and 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This Office Action is in reply to Applicants' response filed on 17 August 2010 ("2010 Aug Response").
2. Claims 1-16 are currently pending.
3. Claims 1-7 and 13 have been examined.
4. Claims 8-12 and 14-16 have been withdrawn, as noted in the previous Office Action mailed on 27 May 2010 (see ¶ 8).
5. This Office Action is given Paper No. 20101011. This Paper No. is for reference purposes only.

Specification

6. The substitute specification and abstract filed on 17 August 2010 have been entered.

Claim Rejections - 35 USC §112, Second Paragraph

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 2-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The claims are replete with errors, an example follows.

Art Unit: 3621

Regarding Claims 2-7

9. Claim 2 recites:

wherein, when the predetermined condition is satisfied, the server apparatus transmits an authorization response in reply to the authorization request, and
wherein, when the predetermined condition is not satisfied, the server apparatus transmits a non-authorization response.

10. The Examiner finds the use of *when*, in the context of the surrounding language, suggests an occurrence (namely, *e.g.*, the occurrence of the “the predetermined condition is satisfied”).

Moreover, an occurrence implies some element of time within the structure of the claimed “system.” For example, at some point in time the occurrence of the “the predetermined condition is satisfied” may happen. Claim 2 is indefinite because it is unclear how the *structure* of the claimed “system” is limited by the occurrence of the “the predetermined condition is satisfied” and on some element of time.

11. Moreover, the suggestion of an occurrence and of an element of time is evidence that a process exists in the claimed system. Therefore, claim 1 is indefinite because it is unclear whether Applicants are claiming a system (in terms of structural components) or a hybrid system/process (in terms of both structural components and a process in which the structural components are used).

12. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, second paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-7 and 13, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al. (U.S. 6,141,483 A) (“Yamada”), in view of Wald et al. (U.S. 207/0124602 A1) (“Wald”).

Regarding Claims 1-7 and 13

15. Yamada discloses:

an optical disc (see at least medium 1) having a disc region code (see at least “medium region code” of c. 2) assigned thereto and having content (see at least “reproduction data” of c. 2); and

a playback apparatus (data reproducing apparatus and host of at least fig. 1) for playing back the optical disc, wherein the playback apparatus comprises:

a control unit (control unit 11 of fig. 2) programmed to judge whether the disc region code assigned to the optical disc matches an apparatus region code assigned to the playback apparatus (c. 12, l. 64 – c. 13, l. 5); and

Art Unit: 3621

a playback unit (host 3 of fig. 1) programmed to play back the content when the control unit judges that the disc region code matches the apparatus region code (c. 12, l. 64 – c. 13, l. 5).

wherein, the control unit is programmed such that, when the control unit judges that the disc region code does not match the apparatus region code (“noncoincidence of region codes” – c. 13, ll. 20-30), the control unit judges whether a combination of content information and the apparatus region code satisfies a predetermined condition defined by an owner of rights of the content (“permission/non-permission data about reproduction/transfer of data” – c. 13, ll. 20-30, fig. 10 – item E, and fig. 12; see also “control data portion 27” as discussed in at least c. 14; see also c. 10 lines 1-15 discussing permissions set by content owners allowing reproduction when regions codes do not match),

wherein, the playback unit is programmed such that, when the control unit judges that the combination of content information and apparatus region code satisfies the predetermined condition defined by the owner of the rights of the content, the playback unit plays back the content recorded on the optical disc (see at least ST20-21 of fig. 12 showing transfer of content to host after predetermined conditions deemed acceptable; see also fig. 12 with associated text), and

wherein, the playback unit is programmed such that, when the control unit judges that the combination of the content information and the apparatus region code does not satisfy the predetermined condition defined by the owner of the rights of the content, the playback unit does not play back the content (see at least ST29 of fig. 12.

16. Yamada does not directly disclose an optical disc having a content identifier identifying the content recorded thereon.

Art Unit: 3621

17. Wald teaches using a content identifier to associate specific permissions with specific items of content (see at least ¶ 0311).

18. Therefore, it would have been obvious to one of ordinary skill in this art, at the time of the invention, to modify Yamada's disc to include a content id for the reproduction data thereon and associated time related permissions, as taught by Wald, in order to allow a content owner to associate permissions with specific items of content (see Wald, ¶ 0292). In this combination, it would be further obvious to modify Yamada's control unit 11 to use a content id, along with the other information regarding the content, in combination with the apparatus region code for determining whether the exceptional playback of regional content is allowed.

19. With particular attention to the additional limitations of claim 13, Yamada further discloses a "use flag" that triggers additional processing to determine whether the content can be played (see c. 18, ll. 40+).

Allowable Subject Matter

20. Claim 6 would be allowable if rewritten to overcome the rejections under 35 U.S.C. §112, 2nd ¶ (set forth in this Office Action), to overcome the existence of all intended use language (*e.g.*, claim 2 recites "a transmitting unit that transmits..."), and to include all of the limitations of the base claim and any intervening claims. A terminal disclaimer would also be needed to overcome the Double Patenting rejection, shown below.

21. When drafting such a claim, the Examiner recommends changing the "wherein the playback apparatus further comprises a transmitting unit that transmits an authorization request ..." (of intervening claim 2) to more structurally definitive language such as 'wherein the

Art Unit: 3621

playback apparatus further comprises a transmitting unit programmed to transmit an authorization request.’ Likewise, the Examiner recommends changing the “when the predetermined condition is satisfied, the server transmits an authorization response” (of intervening claim 2) to ‘the server apparatus is programmed to transmit an authorization response when it has determined that the combination of the content identifier and the apparatus region code satisfy the predetermined condition....’ This latter suggestion would overcome the §112 2nd ¶ rejection, as shown above. Finally, when drafting such a claim, Applicants are respectfully reminded of ¶ 38 of the previous Office Action mailed on 27 May 2010.

22. If the Examiner can be of any assistance in drafting an allowable claim, Applicants are encouraged to contact the Examiner at the number listed below.

Double Patenting

23. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

Art Unit: 3621

Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

24. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

25. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

26. Claims 1-7 and 13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over at least claim 1 of U.S. Patent No. 7,765,158 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-7 and 13 of this application are broader than the issued claims of U.S. Patent No. 7,765,158 B2, and claims 1-7 and 13 of this application only differ from the claims of U.S. Patent No. 7,765,158 B2 in the terminology used (*e.g.*, claim 1 of this application recites “control unit” where claim 1 of U.S. Patent No. 7,765,158 B2 recites “processor”).

Claim Interpretation

27. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his

Art Unit: 3621

interpretation of the claims.¹ Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

event (n.) “1. a. Something that takes place; an occurrence.” The American Heritage® Dictionary of the English Language, 4th ed. Boston: Houghton Mifflin, 2000;

if “1 a : in the event that.” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield, M.A., 1986;

when “2 : in the event that: IF.” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

Response to Arguments

28. Applicants’ arguments with respect to the examined claims have been considered but are moot in view of the new grounds of rejection.

Conclusion

29. Applicants’ amendment filed in the 2010 Aug Response necessitated the new grounds of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

¹ While most definitions are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

Art Unit: 3621

30. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112, first paragraph written description and enablement, §112, second paragraph indefiniteness, and §102 and §103, prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

31. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3621

32. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

33. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/
Patent Examiner, Art Unit 3621
11 October 2010

/EVENS J. AUGUSTIN/
Primary Examiner, Art Unit 3621